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09/053,832 04/01/98 OWENS

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EXAMINER

QM22/0313

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GOODMAN, C
ART UNIT

PAPER NUMBER

3724
DATE MAILED:

03/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/053,832

Applicant(s)

OWENS, WILLIAM M.

Examiner

Charles Goodman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2000.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 06 July 2000 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

1. The Amendment filed on December 21, 2000 has been entered.
2. The Amendment filed on July 6, 2000 has been entered in part only with respect to the claims.
3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on July 6, 2000 have been approved.

Election/Restrictions

4. Claims 9-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species II, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Specification

5. The disclosure is objected to because of the following informalities:
 - i. It is noted that in the specification, the line numbers on the left margin of the papers do not match with the actual lines. Thus, the following line number designations are referring to the *actual* line number(s) as it appears on the specified page rather than the ones shown in the left margin.
 - ii. P. 3, ll. 18-21, the use of the trademarks "Scandera Red Carbox Rough Top" and "Browning Manufacturing Company" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks

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is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

- iii. P. 5, l. 13, the phrase “spring or pneumatic cylinder loaded arm (12, 18, 20, 45)” is not clearly understood. References “12” and “45” have been used to designate a “spring loaded arm”, and now they are referred to as a “pneumatic cylinder loaded arm”. Which is which? If the arms 18, 45 can also be “pneumatic cylinder”, then it is suggested that this alternative be set forth during the first instance of the references so that the specification is clear.

Appropriate correction is required.

Drawings

- 6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the capability of the saws being remotely adjusted must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Objections

- 7. The claims in this application do not commence on a separate sheet in accordance with 37 CFR 1.52(b). Appropriate correction is required in response to this action.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-8 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with vague and indefinite language and lack of antecedent basis for claimed features. The following are some noted examples. Applicant is advised to thoroughly review the claims for compliance with the above statute. Failure to do so will result in the next Office Action being FINAL.

- i. The following phrases lack clear antecedent basis: (claim 1) "the material's length", "the non-skid continuous conveyor belts", "the input non-skid continuous conveyor belt", "the output non-skid continuous belt", and "the same operating revolutions per minute" (note that the belts were referred to as "belt means" not "belts"); (claim 2) "the length", "the belts direction of travel", and "the motor means"; and (claim 3) "its length".
- ii. Claim 1 is vague and indefinite in that it is not clear what the claim encompasses. The claim is characterized as an improvement, yet the claim does not set forth what that "improvement" is. See e.g. Jepsom claims, MPEP 2129. Note again that the claim includes many confusing instances between the "belt means" and "belts". Each is subject to different interpretation. In claim 1, l. 7, the term "it" is vague and indefinite. What

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is "it" referring to? The same applies to all instances of the term and "its" in the claims.

- iii. Claim 2 is vague and indefinite in that it is not clear what the claim encompasses. Claim 1 is directed to features that are specific to "feeding", yet the present claim include features that are directed to the "powered cutting means". What is the scope of the invention? Is it in the "feeding means" or the combination of the "feeding means" and the "powered cutting means"? If the latter, then claim 1 should be more clear on this issue.
- iv. Claim 6 is vague and indefinite in that it is not clear what the claim encompasses. Where is this "capability" shown?
- v. The claims are replete with similar problems noted in the last Office Action. They are too numerous to mention, and Applicant is advised that the above are only examples.

Claim Rejections - 35 USC § 102

- 10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 11. As best understood, claims 1, 3-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffa.

Hoffa an apparatus for cutting wire comprising all the elements claimed including a powered cutting means (at 100 in Fig. 1); an input non-skid continuous conveyor belt means 13; an output non-skid continuous conveyor belt means 15; a hold

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down means 12, 14; a guide means (between the outer flanged portions of sprocket 44 – see, e.g., Figs. 1 and 5); drive means 56, 44, 47 that rotate both input and output conveyor belt means at the same RPM; the conveyor belt means including a material having the length, width, and a guide V-belt; the drive means including a V-groove (due to the sprocket design); a feed bed (see structure between the conveyor belt means in Fig. 1); an inside feed roller 44; a feed roller 45; a timing belt 50, 51; and the hold down means having a plurality of hold down rollers (see rollers at 14 in Fig. 1). See whole patent.

Regarding the work being a flat, rigid, cuttable material, this has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. As best understood, claims 1-6, 8, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmerman in view of Chambers and Baranski.

Zimmerman discloses the invention substantially as claimed including powered cutting means 168a, 168b...172a, 172b; input conveyor means 36; output conveyor means 38; hold down means 98, 100, 102, 104, 110, 112 which include pneumatic cylinder loaded arm means 144; and drive means (Fig. 3). See also Figs. 1, 2, 5, and 7.

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However, Zimmerman lacks (1) the input and output conveyor means each being continuous belt means and (2) guide means.

Regarding (1), although Zimmerman lacks the input and output conveyor means each being continuous belt means, Chambers clearly teaches that continuous belt means are art recognized equivalent means of feeding work material to and out of the cutting station of a powered cutting means. More specifically, Chambers teaches, in a sawing device, an input non-skid continuous conveyor belt means 10 that move the to be cut material 12 to a cutting means 16, 18 and an output non-skid continuous conveyor belt means 20 that move the cut material 12' out of the cutting means which are the same functions as that of Zimmerman's conveyor means. See Fig. 1. Therefore, because these two input and output means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the input and output continuous conveyor belt means of Chambers for the input and output roller conveyor means of Zimmerman for the reasons stated *supra*.

Regarding (2), the modified device of Zimmerman discloses the invention substantially as claimed except for guide means. However, Baranski teaches, in a resaw device, a guide means 114, 116, 122, 124 that maintains the position of a non-skid continuous conveyor belt means 80 relative to the cutting means due to the conveyor belt means having a guide V-belt 156 riding in V-grooves 124, 122 on an inside feed roller 128 and a feed roller 126, respectively, and a V-groove 120 on a feed bed 114, 116 wherein all these features prevent lateral movement of the conveyor belt during rotation thereof. See. Figs. 4-5, c. 4, l. 22-68. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified device of

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Zimmerman with the guide means as taught by Baranski in order to facilitate positive guidance and accurate positioning of each of the continuous conveyor belt means by preventing lateral movement of the conveyor belt means during the longitudinal movement of the conveyor belt means.

Regarding the work being a flat, rigid, cuttable material, this has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 6, the phrase "capable of being set..." has not been given significant patentable weight, since it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

14. As best understood, claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmerman in view of Chambers and Baranski as applied to claims 1-6, 8, and 14 above, and further in view of Conrad.

The modified device of Zimmerman discloses the invention substantially as claimed including the thickness of the belt means. However, Zimmerman, modified, lacks the scallop shaped cuts.

First, it is noted that the thickness and the composition of the continuous conveyor belt and notch grip belts (which include the scallop shaped cuts) are disclosed as commercially available materials and thickness for a conveyor belt having a guide V-

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belt. As such these are deemed obvious to one of ordinary skill in the art. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified device of Zimmerman with the physical and material characteristics of the conveyor belt as claimed since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Second, even if Applicant argues to the contrary, Conrad teaches a continuous conveyor belt means wherein the belt includes guide V-belts (e.g. 34) having scalloped shaped cuts (Fig. 2) for the purpose of maximizing the flex of the belt. See c. 1, ll. 61-65. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified device of Zimmerman with the scallop shaped cuts in the guide V-belts as taught by Conrad in order to maximize the flex experienced by the conveyor belt means during movement thereof. Moreover with regards to the thickness and the material of the belt, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified device of Zimmerman with the thickness and the material as claimed in order to provide the belt with optimum thickness and frictional characteristics for the desired conveyance and work environment, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art, *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

15. Applicant's arguments filed July 6, 2000 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that Hoffa does not anticipate the claimed invention merely because Hoffa is not in the wood cutting industry,¹ this argument lacks weight. First, Applicant is reminded that the work has not been given significant patentable weight. It is intended use, and as such, it does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations *Ex parte Masham*, 2 USPQ2d 1647 (1987). Second, Applicant's assertion that in order for a reference to be an anticipating reference, the reference must be identical to the invention² is far off the mark. It is the claims that are important in determining this issue, not merely the disclosed. Moreover, nothing in 35 USC 102(b) states that a patented or described invention must be identical. Third, while the Declaration of the Applicant is permitted, it has no bearing on anticipation since this is an issue of law. Fourth, Applicant's assertion that the lack of citing any extrinsic evidence for purposes of 35 USC 102(b) is confusing.³ It is not clear why such extrinsic evidence is necessary when the Examiner offered proof in the Hoffa reference. Fifth, Applicant's assertion that Hoffa is immaterial is again far off the mark.⁴ This may have relevance if Hoffa was involved in an obviousness issue, but in this case, it is not. Thus, this is deemed irrelevant.

¹ Amendment A, Paper No. 7, p. 6, l. 20 - p. 7, l. 22.

² *Id.*, p. 7, ll. 5-8.

³ *Id.*, p. 7, ll. 9-16.

⁴ *Id.*, p. 7, ll. 17-22.

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In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning,⁵ it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Response to Amendment

Declaration of Dennis M. Langlitz

16. The declaration under 37 CFR 1.132 filed July 6, 2000 is insufficient to overcome the rejection of claims 1-8 based upon Hoffa, Zimmerman, Chambers, and Baranski as set forth in the last Office action because: they fail to set forth facts and the facts presented are not germane to the rejection at issue.

The declaration refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

⁵ *Id.*, p. 8, ll. 4-13.

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In response to Declarant's statement that Declarant was not aware of the Owen's machine and that the novelty lies in its mechanical simplicity, *inter alia*,⁶ this statement is unpersuasive. Just because something is new does not mean that it is patentable. Moreover, the mechanical simplicity of use and ease of operation are not germane to the issue of whether or not the *claimed* invention is anticipated.

In response to Declarant's statement that the Owen's machine has satisfied a long felt need is again unpersuasive.⁷ First, Declarant fails to even identify exactly what that long felt need is. There is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no showing that persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references and still were unable to solve the problem. See MPEP §716.04. Second, if the long felt need is for a feeding and sawing machine that is low cost with quality results, then this is all relative. As both Declarant and Applicant are fully aware, the wood industry is full of products that can meet this need depending on how much resources the buyer or business is willing to invest. Moreover, the failure to solve a long felt need may be due to factors such as lack of interest or lack of appreciation of an invention's potential or marketability rather than want of technical know-how. *Scully Signal Co. v. Electronics Corp. of America*, 570 F.2d 355, 196 USPQ 657 (1st. Cir. 1977). Furthermore, if the simplicity of the Owen's machine results in a much lower price (presumably relating to the long felt need), then it is not clear to the

⁶ See Langlitz declaration, p. 1, ll. 17-21. Note that the line numbers are based upon the actual number of the line rather than those shown in the left margin.

⁷ *Id.*, p. 2, ll. 1-7.

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Examiner why the second purchased machine cost close to \$ 12,000 *more* than the first one.⁸ Why would such simplicity require such a higher price in little more than a year?

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Declaration of William M. Owens (Inventor)

17. The declaration under 37 CFR 1.132 filed July 6, 2000 is insufficient to overcome the rejection of claims 1-8 based upon Hoffa, Zimmerman, Chambers, and Baranski as set forth in the last Office action because: the showing is not commensurate in scope with the claims.

First, the Declarant is the inventor of the instant application. Due to this fact, Declarant's statements are less persuasive than a disinterested person. However, this does not mean that Declarant's statements will be disregarded for this reason alone. *Ex Parte Keyes*, 214 USPQ 579 (Bd. App. 1982); *In re McKenna*, 203 F. 2d 717, 97 USPQ 348 (CCPA 1953). Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive. *In re Chilowsky*, 306 F.2d 908, 134 USPQ 515 (CCPA 1962); *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967).

Second, Declarant's statements that Hoffa does not solve the problem identified by Declarant and Hoffa is not involved in the wood industry have no bearing on the fact

⁸ *Id.*, p. 2, ll. 5-7.

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that Hoffa anticipates the claimed invention.⁹ Declarant's statements are referring only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. The fact that the Hoffa reference is classified elsewhere than where one would normally see wood industry inventions are not germane to the ultimate legal conclusion that Hoffa anticipates the claimed invention. It is a conclusion of law, and as such, Declarant's statement on this issue is not entitled to any weight.

Third, Declarant asserts long felt need. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no showing that persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references and still were unable to solve the problem. See MPEP §716.04. Moreover, the failure to solve a long felt need may be due to factors such as lack of interest or lack of appreciation of an invention's potential or marketability rather than want of technical know-how. *Scully Signal Co. v. Electronics Corp. of America*, 570 F.2d 355, 196 USPQ 657 (1st. Cir. 1977).

Fourth, Declarants traverses each of the references used in the obviousness rejection individually. Again this falls in the realm of ultimate legal conclusion. In response thereto, the Declarant cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

⁹ See Owens declaration, p. 2, l. 23 - p. 4, l. 10.

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Fifth, the comparative data submitted in the declaration is noted. However, it is not clear what the data is showing or what it is trying to prove. What were the controls involved in obtaining this data? Where is the comparison with the more expensive machine? How much more expensive was it, and how relevant is this machine to the claimed invention? Where is the nexus between the claimed invention and the comparative results? Lacking this information, the data chart is entitled to little weight.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501.

The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM

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EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**rinaldi.rada@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.


Charles Goodman
Patent Examiner
AU 3724

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March 12, 2001